



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,587	10/07/2003	Thomas L. Barnhart	170707-1016	6858
24973	7590	02/11/2008	EXAMINER	
LAW OFFICE OF SANFORD J ASMAN			JANVIER, JEAN D	
570 VINGTON CT			ART UNIT	PAPER NUMBER
ATLANTA, GA 30350-5710			3622	
MAIL DATE		DELIVERY MODE		
02/11/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/681,587	<b>Applicant(s)</b> BARNHART ET AL.
	<b>Examiner</b> JEAN JANVIER	<b>Art Unit</b> 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-8 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

### **Response to Applicant's Arguments**

Here, the 37 CFR 1.111 response is not sufficient to render the applied reference (article) unavailable as prior art. As discussed during a phone conversation with the Attorney of record, the most effective way to eliminate this article (FASTBALL.com's Decode & Win Game) as a prior art reference is to submit an Affidavit in accordance with the MPEP guidelines. Furthermore, although the said article refers to a "patent pending", however, it is impossible to conclude therefrom that the "patent pending" is associated with any application related to the Instant Application. Additionally, the Examiner cannot verify the assignment independently provided by the Applicant. Having said that, only an Affidavit can help remove the article as prior art, thereby overcoming the 102(a) rejection.

Thus, since there is no other issue regarding the Office Action per se and since the Applicant's response is not plausible, the last Office Action is still maintained, as shown below, and thus, the present Action has been made final.

### **DETAILED ACTION**

#### *Specification*

#### *Claim Status*

Claims 1-8 are pending in the Instant Application.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Ray, Debra, in an article "**FASTBALL.com's "Decode & Win Game"** ", published on November 1997 (Dialog 01539026 01-90014).

As per claims 1-8, Ms. Ray describes, in the article, that FASTBALL.com's Decode & Win Game proved that a compelling promotion can not only generate trial, but also bring repeat visitors or players to an online service or website **in order to increase traffic at the said web site (reading on the step of providing a website at which a game is being played, a product promotion is being conducted....).**

Further, in the article, Ms. Ray continues by pointing out that the marketing dilemma of the 1990s was: How can producers of a new Internet Web site get people or visitors to try it or to visit it to thereby increase traffic at the said website? (Same problem as the one this Application is trying to solve). Here, to address this problem or dilemma, Cox Interactive Media's FASTBALL.com had completed a four-week promotion that set new benchmarks for on-line/Internet promotions.

In fact, a direct mail campaign to a test cell of 7,000 FASTBALL.com users generated had interest or participation in excess of 40 percent (increasing traffic at the featured site by 40 percent). Compared to national direct mail response rates that usually average in the one to five percent range, FASTBALL.com's "Decode & Win Game" promotion had proved that a compelling (product) promotion can not only generate trial or interest, but also bring repeat visitors to an on-line service (website). In general, the direct had invited the visitors (site

users) or potential players to visit the website and participate in a promotional game (sweepstakes entry) by using a provided game indicia (game piece).

About the Game:

Indeed, "The Promotions Unlimited, Inc.", an Atlanta-based sales promotion agency, had developed the "Decode & Win Game," in conjunction with Cox Interactive Media, using a patent-pending decoder device (game device) delivered through a direct mail campaign. The direct mail piece was sent to a test cell of 7,000 FASTBALL.com users throughout the country (providing a game piece to the users). The mailing directed consumers to a special contest page within the domain of the FASTBALL.com on-line service (the communication or direct mail invited the users to visit the featured site and participate in a contest using the received or provided game piece). The Grand Prize for the "Decode & Win Game" or contest was a trip for two to any of the six newest baseball stadiums in the U.S. Other prizes included baseball memorabilia.

**The FASTBALL.com "Decode & Win Game" piece contained a hidden word** (camouflaged image), which was not visible without assistance (which cannot be decoded without special means). To decode the hidden word or to reveal the camouflaged image imprinted on the game piece, players or individuals interacted with the featured website when placing their game piece against a specially colored background (lit background) appearing in the FASTBALL.com/contest page to reveal the winning status of the game piece (placing the game piece in proximity of a light source or colored background to reveal the winning status of a game piece).

In addition, each game piece contained a unique account number to identify individual

players and keep track of the number of times they visited the site (a game piece is unique).

To participate, players entered their account numbers.

Each week for four weeks, a different word was selected as the winner.

Players were asked to enter each week for four weeks.

Participants in the FASTBALL.com promotion played an average of 2.1 times during the four-week period, with many returning each of the four weeks during the contest (reasonable achievement).

Finally, the next step in the program requires FASTBALL.com to recruit sponsors for the national rollout of the "Decode & Win Game." In addition to direct mail, the national contest could be delivered through consumer print media, in-pack, on-pack, over-the-counter and at point-of-purchase (delivering contest invitation to potential users via a plurality of media).

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.  
Official Draft : 571-273-8300

02/02/08

/JDJ/

/Jean D. Janvier/

**Primary Examiner, Art Unit 3622**